

First, and as stated earlier, linking claims 30 through 48 are newly added to directly link claims 5-21 of non-elected Group II and claims 22-29 of non-elected Group III to claims 1-4 of elected Group I. Under M.P.E.P §809.04, Applicants are entitled to retain claims 5-21 of the non-elected Group II and claims 22-29 of the non-elected Group III. The Examiner must examine linking claims 30 through 48 on their merits. When claims 30 through 48 are determined as allowable over the prior art, the Examiner must also examine claims 5-29 of the non-elected Groups II and III.

Second, under M.P.E.P §806.05(c), in order to establish that combination claims of elected Group I and claims of non-elected Groups II and III are distinct, **two-way** distinctness must be demonstrated. Both two-way distinctness and reasons for insisting on restriction are necessary. The Examiner must show that:

- (1) a combination as claimed does not require the particulars of the sub-combination as claimed for patentable; and
- (2) a sub-combination can be shown to have utility either by itself or in other and different relations, the inventions are distinct.

A sub-combination is an essential feature of the claimed combination when the combination requires the particulars of the sub-combination; otherwise, the combination would not function in its intended mode of operation. In the present situation, the Examiner has not demonstrated the **two-way** distinctness between the claims of non-elected Groups II and III and the claims of elected Group I. The Examiner has not demonstrated why the combination claims of Groups II and III directed to “an information display system” would not require the particulars of sub-combination claims 1-4 of Group I directed to “a navigation display system”. Instead, a

form paragraph under M.P.E.P. §806.05(c) was inserted without providing any reasons as to how the two-way distinctness requirement under M.P.E.P §806.05(c) has been met.

Lastly, under M.P.E.P §806.05 and §808.02, even assuming *arguendo* that the related inventions as claimed are shown to be distinct, the Examiner must still show by appropriate explanation one of the following: (1) separate classification thereof; (2) separate status in the art when they are classifiable together; (3) a different field of search. In the present situation, the Examiner has not provided sufficient explanation as to why the different species of elected or non-elected inventions contain separate classification, separate status and/or require a different field of search. A review of the record reveals that the claims of the non-elected Group II share the same classification (Class 340, subclass 995) with the claims of the elected Group II, and that many of the claims of non-elected Groups II and III share similar scope as that recited in the elected invention as defined, for example, in independent claim 1. A search of the many apparatus claims of the non-elected Groups II and III would necessarily include a search of the apparatus claims 1-4 of elected Group I as defined. M.P.E.P. §803 states, in part:

“If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

In the present situation, there is no undue burden on the Examiner to search and examine the entire application.

In view of the foregoing reasons, Applicants respectfully submit that the Examiner has not satisfied the criteria for a restriction requirement under M.P.E.P §803, nor has the Examiner demonstrated any serious burden for a search and a complete examination of all

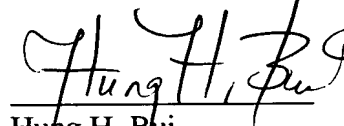
claims on the merits. Accordingly, Applicants respectfully request that such a restriction requirement be withdrawn in favor of a complete examination of all pending claims in this instant application. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

A fee of \$654.00 is incurred by the addition of nineteen claims in excess of twenty and four independent claims in excess of three. The check of Applicants' attorney payable to the order of the Commissioner of Patents & Trademarks and drawn in this amount, accompanies this paper.

To the extent necessary, the applicants petition for an extension of time under 37 C.F.R. §1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, or credit any overpayment of fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (503.35636X00).

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

A handwritten signature in black ink, appearing to read "Hung H. Bui", is written over a horizontal line.

Hung H. Bui  
Registration No. 40,415

CIB/HHB  
(703) 312-6600  
Antonelli, Terry, Stout & Kraus, LLP  
1300 North Seventeenth Street  
Suite 1800  
Arlington, VA 22209  
(703) 312-6600 (phone)  
(703) 312-6666 (fax)